

REMARKS

Claims 1, 4-6, 8-17, 20 and 21 are pending in this application. Claims 1, 4-6, 8-17, 20 and 21 are rejected. Claim 3 has been cancelled. Claims 1, 4, 5, 8, 10, 12 -17, and 20 - 21 have been amended. Claims 1, 4-6, 8-17, 20 and 21 remain pending for reconsideration, which is respectfully requested.

I. REJECTION OF CLAIMS 1, 4-6, 8-17, 20 and 21 UNDER 35 U.S.C. 103(a) AS BEING UNPATENTABLE OVER BERNSTEIN (U.S. PATENT PUBLICATION NO. 2002/0107730) IN VIEW OF HERZ (US. PATENT NO. 5,754,938)

In item 2 on page 2 of the Office Action claims 1, 4-6, 8-17, 20 and 21 were rejected under 35 U.S.C. §103(a) as being unpatentable over Bernstein (U.S. Pub. No. 2002/0107730) (hereinafter "Bernstein") in view of Herz (U.S. Patent No. 5,754,938) (hereinafter "Herz"). This rejection is respectfully traversed.

Claim 1 is directed to a marketing method which promotes to users, sales of product groups including a first product group that a first provider provides and a second product group that a second provider provides **prior to purchase**.

Applicants respectfully submit that Bernstein fails to disclose, either expressly or inherently, the claimed **"selection of a first product in the first product group in which a user takes an interest"** because para. [0025] as cited in the Office Action on page 3 recites "where a first vendor is offering the promotional materials and a customer **makes a purchase** from another vendor, **a summary of the purchase** may be sent to the database... The promotional materials in fact, may be printed on the back of a sales receipt provided by the vendor at the **point of sale**." The Office Action further admits: "For a customer purchase history to be present, there must be a quantity **purchased** of at least 1 stored." Paragraph [0017] of Bernstein makes this requirement even clearer by describing the "customer profile" based on "purchases of the same products, similar products, or a locale of purchases." Claim 1 does not recite requiring a purchase. Nothing has been cited or found in Herz which cures the deficiencies of Bernstein. The cited Figure 14, reference 1401 relates to utilization of a pseudonym, and does teach or suggest the above mentioned features of claim 1. Thus, it is submitted that claim 1 is patentably distinguishable over Bernstein in view of Herz for the reasons discussed above.

Thus, Bernstein also fails to disclose selection of a different product based upon a product attribute and also fails to disclose either expressly or inherently or teach or suggest

“presenting the product attribute to the first product information relating to the first product and the second anonymous user identifier to the second provider” as well as the claimed “reading out, from the stored second product information, second product information that includes the **product attribute related to said first product** and that includes a product name different from the product name of said first product” to the user **prior to purchase**. The Office Action, on page 3, cites paragraphs [0014], [0016], and [0023] of Bernstein as “providing to the consumer a recommendation of a different product from a different merchant based on the first **selected product**” but this is in error because Bernstein’s disclosure does not teach selection, but rather **requires a purchase** as admitted in the Office Action.

Paragraph [0014] of Bernstein, recites “accumulat[ion of] information regarding buying preferences and habits of individual customers” and paragraph [0016] refers to “a history of purchasing in the locale” and “previously purchased complementary products or services” while paragraph [0023] refers to a “purchase transaction.” However, as claimed in claim 1, a second product is presented to the user prior to purchase based not upon a required purchase history, **but merely upon the product attribute**. Nothing has been cited or found in Herz that cures the deficiencies of Bernstein discussed above. Thus, it is submitted that independent claim 1 is patentably distinguishable over Bernstein in view of Herz for the reasons discussed above.

In addition, both Bernstein and Herz fail to disclose, teach or suggest the claimed feature: “**second anonymous user identifier**” which is presented “to the second provider.” The Office Action, on page 3, admits that “Bernstein doesn’t appear to specify the identifier as varying for each merchant” but that “Herz teaches the ability of a user to vary his information per merchant” and that “it would have been obvious to one having ordinary skill in the art at the time the invention was made to create a different identifier for each merchant in the interest of enhancing consumer privacy.” However, as admitted in the Office Action, in Herz and in Bernstein, the user is required to request to vary his own information between merchants such that he remain anonymous, but as claimed in claim 1, the user is not required to do anything in order for “the second anonymous user identifier” to be presented “to the second provider.” According to Herz’s Abstract, “the user [has] control over the ability of third parties to access this summary and **to identify or contact the user**.” In other words, Herz’s users are not anonymous.

In light of the foregoing, Applicants respectfully submit that independent claims 1, 14, 15, 16, 17, and 20 are patentable over the references, as neither Bernstein nor Herz, either alone or in combination, discloses or suggests the above identified features of claim 1. For the reasons above, it is submitted that dependent claims 4-6, 8-13 and 21, which depend from claim 1, are

patentably distinguishable over Bernstein and Herz, individually or in combination. The dependent claims also recite additional features not taught or suggested by Bernstein or Herz. For example, claim 5 recites “accepting from the user, based on the first user identifier, an instruction to purchase said second product; and carrying out a payment process for said second product, utilizing the second user identifier corresponding to the first user identifier” which inherently shows, based upon claim 5’s dependency from claim 1 that a second product may be purchased without purchase of a first product. In particular, Bernstein does not expressly or inherently teach carrying out a purchase of a second product based merely upon a product attribute related to product one and product two. Regarding claim 21, “deletion of the second user identifier if the product is not selected” does not require a purchase, but only a selection. Thus it is submitted that the dependent claims are independently patentable over Bernstein and Herz.

Finally, independent claim 23 is patentable over the references because neither Bernstein nor Herz, alone or in combination teaches:

reading out product information from the first, second, and third product groups, based on the preference and the stored product information, the product information that includes the product attribute related to said product and that includes a product name that is different from the product name of said product;

receiving from the first provider, read out first product information, receiving, from the second provider, read out second product information and the second anonymous user identifier and receiving, from the third provider, read out third product information and the third anonymous user identifier

because while the preference is related to a purchase date or a quantity purchased, the stored product information is based upon product attributes alone. Thus, selecting two products is sufficient. Prior purchases are not required before a third product is suggested to the user based upon the “product attribute” as indicated in the original disclosure in Fig. 11 and paragraphs [0098] and [0099], but could assist in promoting a product. In addition, the both the second and third user identifiers are kept anonymous.

II. CONCLUSION:


In view of the foregoing amendments and remarks, it is respectfully submitted that each of the claims patentably distinguishes over the cited references, and therefore, defines allowable subject matter. A prompt and favorable reconsideration of the rejection along with an indication of allowability of all pending claims are therefore respectfully requested.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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